

REMARKS/DISCUSSION:

This Amendment A is being filed within three months after the shortened statutory period for response that ended on September 11, 2003.

Accordingly, a Petition for a Three-Month Extension of Time is attached hereto.

By this Amendment A, claims 21-25 and 27-28 are pending in this application. Claims 19-20 have been withdrawn, and Claim 26 has been canceled.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Rejection under 35 U.S.C. § 112

Claims 21-26 stand rejected as being indefinite.

The Examiner first states on page 3 of the Office Action that “the applicant alleges that the blade (88) comprises element 202, page 18, lines 30-34”. The Examiner’s attention is directed to page 17, lines 12-27. Here it is clear that referring to Fig. 23, the end effector 180 comprises a blade 88 and a clamp arm assembly 300. Further, the clamp arm assembly 300 comprises a clamp arm 202 and a tissue pad 208. Applicant is unable to locate within the specification and disclosure that indicates that the blade 88 comprises element 202.

The Examiner goes on to state “the blade, according figure 23, element 88, clearly does not comprise a curved portion or a balance portion.” Applicant respectfully disagrees with the Examiner’s assertion that fig. 23 does disclose a curved portion. Blade 88 has a curved feature as is readily apparent upon inspection of Fig. 23. Further, one embodiment to balance blade 88 is disclosed starting on page 28, line 19 of the specification.

The Examiner further states that “the waveguide does not actually comprise element 88, rather it is attached to element 88”. Claim 21 has been amended to clearly define the relationship between the waveguide and the blade 88.

The Examiner also states the “the ‘balance portion’ is not mentioned in the specification”. Again, reference is made to the specification starting on page 28, line 19 of the specification. Although the term “balance portion” is not specifically cited in the specification, the cited text discusses balancing the blade to minimize excursions, *inter alia*, in the z-direction. One embodiment to balance the blade is “by providing a functional asymmetry optimized to minimize z-axis excursion in ultrasonic waveguide 179”. Page 29, lines 13-15. Accordingly, Applicant has amended the claims to replace “balance portion” with an equivalent terminology as used in the specification.

Regarding claim 23, the Examiner states “the applicant states the balance portion extends to a point proximal to the treatment portion. It is not clear how if element A comprises element B, element B can extend to point proximal of element A.” Applicant is unsure the nature of the indefiniteness relating to claim 23. Specifically, the functional asymmetry extends from the distal end of the blade, within and through the treatment portion and continues beyond the treatment portion to terminate at a point beyond and proximal to the treatment portion.

Rejection under 35 U.S.C. § 102(e)

Claims 21-24 and 26 stand rejected as being anticipated by U.S. Patent No. 6,117,152 to Huitema. Regarding claims 21-23, the Examiner states that Huitema discloses a waveguide 50 comprising a blade 56 a distal portion (right side of the notch 59) and a proximal portion left side of the notch, a curved treatment portion right portion at the right portion of the first figure attached to the Office Action. The Examiner has also labeled a balance portion and states that the notch provides asymmetry. The rejection of Claims 21 and 23 are rejected under different interpretations of fig. 3 disclosed by Huitema (see the annotated figures on pages 8 and 9 of the Office Action).

Applicant respectfully transverses the Examiner's rejection of Claims 21-24 and 26 over Huitema because, according to Applicant's understanding, the Huitema reference neither teaches nor suggests the elements of the Applicant's invention. It is Applicant's understanding that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See for example MPEP 2131.

Independent claims 21 and 24 (claim 26 is canceled without prejudice to the Applicant) include the following limitation:

a curved treatment portion, and the curved treatment portion comprising at least one functional asymmetry, wherein the functional asymmetry is positioned to counter torque created by the curved treatment portion.

The Huitema reference does not, according to Applicant's understanding, teach or suggest at least one functional asymmetry, wherein the functional asymmetry is positioned to counter torque created by the curved treatment portion. Nor has the Examiner identified any portion of the Huitema reference that teaches Applicant's claimed structure or even discloses an appreciation that torque is created by the curved treatment portion identified by the Examiner. In pages 8 and 9 of the Office Action the Examiner has simply *assumed* that certain portions of the blade illustrated in Fig. 3 in Huitema are balance portions, without any suggestion from Huitema that balance portions even exist in the disclosed blade design. Therefore, according to the Examiner, the alleged balance portions shown in pages 8 and 9 of the Office Action counter torque created by the curved treatment section of Huitema without any suggestion by Huitema that torque created by the curved treatment section even exists in the disclosed blade or is a problem that needs to be addressed. Further, nothing in the text of the Huitema reference supports the Examiner's contention that the alleged balance portions identified in the Office Action even is a balance portion or that there are any elements illustrated or described in Huitema that counter torque created by the curved treatment portion. The Examiner has simply assumed that the

Huitema blade is balanced without any support from the Huitema specification.

The only discussion Huitema provides regarding the shape of the blade relates to the blade's functional use and to facilitate anatomical access and visualization during the use of the ultrasonic instrument. Col. 4, line 52 through col. 5, line 20. There is not even a hint that the shape of the Huitema blade contributes to a balance function.

Further, Applicant respectfully traverses the Examiner's rejection of claims 21-24 because the rejection is based on impermissible hindsight and not upon the actual teaching of the Huitema reference. Specifically, the Examiner has taken Applicant's problem and teaching to overcome the problem and proposing, without support in the Huitema reference, that Fig. 3 incorporates Applicant's claimed invention to solve a problem that Huitema does not even recognize. The Examiner's assumption that the blade in Huitema generates undesirable torque and the Examiner's contention that the blade in Huitema is balanced appear to be based solely on the combination of Applicant's teaching and hindsight. Accordingly, Applicant respectfully requests reconsideration of this rejection.

Claims 21-23 and 26 are rejected as being anticipated by US Patent no. 6,283,981 to Beaupre. The Examiner states that Beaupre discloses a waveguide comprising a blade (28 and 26) with a distal and proximal end, a treatment portion (26) comprising a balance portion (32 and 37), which is a balance asymmetry. Applicant respectfully disagrees with the Examiner's interpretation of what Beaupre discloses.

The Examiner's attention is initially directed to column 3, line 48 through col. 4, line 7. Specifically, Beaupre teaches a treatment region 26 and a *separate* balance region 28—not a treatment region *comprising* a balance region as stated by the Examiner. A convex bottom surface (32) and a central ridge (37) are included within the treatment region 26—and are not disclosed to be balance portions as asserted by the Examiner. Further, and quite clearly,

Beaupre teaches within the balance region 28 a first cutout 38 and a second cutout 40, *which act as asymmetric balance features*. Beaupre neither discloses nor suggests balance features within the treatment region as is claimed by Applicant.

The Beaupre Patent goes on to state:

In an ultrasonic instrument designed according to the method of the present invention, the balance portion generally extends from a node point on the ultrasonic transmission rod to the *proximal end of the treatment portion*.

(Col. 2, lines 51-55, *emphasis added*).

The Beaupre Patent teaches a treatment portion 26 comprising a functional feature known as a functional asymmetry. Specifically, the treatment portion is the area of the blade that contacts the tissue that is under treatment by the ultrasonic surgical instrument. Proximal to the treatment portion 26 is a balance region 28 where balance features are incorporated. Proximal to the balance region 28 is the ultrasonic transmission rod (see Figs. 2-9 of the Beaupre Patent).

See also, page 4, lines 12-15 of the instant application. "While U.S. patent application Ser. No. 09/106,686 [a related Beaupre application] has proven eminently successful at balancing blades and waveguides *proximal to the balance asymmetry*, there are some applications where some balancing may be desirable within *the functional portion* of an asymmetric blade." (*emphasis added*)

The instant invention discloses and claims balancing *within* the functional portion (i.e. the curved treatment portion) of an asymmetric blade as clearly recited in claim 21.

a curved treatment portion, and *the curved treatment portion comprising*
at least one functional asymmetry, wherein the functional asymmetry is positioned to counter torque created by the curved treatment portion. (*emphasis added*)

Applicant respectfully requests reconsideration of the rejection.

Rejection under 35 U.S.C. § 103

Claims 24 and 25 stand rejected as being unpatentable over Beaupre '981 in view of Huitema '152. Based on the previous discussions, Beaupre nor Huitema, alone or in combination, disclose or suggest the claimed invention. Reconsideration is requested.

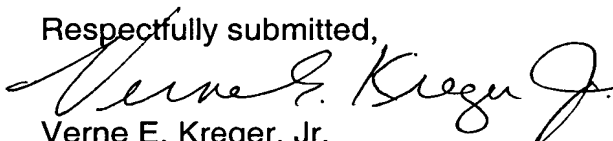
Conclusion

Applicant submits that in view of the discussion, the rejections under 35 U.S.C. §§ 102(e) and 103 have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END-736/VEK. This Authorization is being submitted in triplicate.

Respectfully submitted,



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